

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES E. ISSLER

Appeal No. 2002-1268
Application 09/282,672

ON BRIEF

Before FRANKFORT, MCQUADE, and BAHR, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

James E. Issler appeals from the final rejection (Paper No. 19) of claims 1 through 22, all of the claims pending in the application.

THE INVENTION

The invention relates to footwear. Representative claims 1

surface, and an upstanding sidewall integrally molded with and around a periphery of the midsole;

attaching the upper to the midsole in a single stitching operation by stitching a thread along a peripheral portion of the upper and the sidewall of the midsole; and

attaching an outersole having a walking surface and an attachment surface opposite to the midsole, the outer surface of the midsole positioned adjacent to the opposed attachment surface of the outsole.

12. Footwear comprising:

an upper defining a volume for receiving a wearer's foot and having an open bottom;

a midsole, having an upper surface enclosing the open bottom of the upper, an outer surface opposite to the upper surface, and an upstanding sidewall integrally molded with and around a periphery of the midsole;

a single stitching seam, attaching the upper to the midsole along a peripheral portion of the upper and the sidewall of the midsole; and

an outsole, having a walking surface and an attachment surface opposite to the walking surface, the outer surface of the midsole attached to the attachment surface of the outsole.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Boys, II et al. (Boys)	4,783,910	Nov. 15, 1988
Marc	5,068,983	Dec. 3, 1991
Gross	5,077,915	Jan. 7, 1992
Tilles et al. (Tilles)	5,146,698	Sep. 15, 1992
Bates et al. (Bates)	5,493,792	Feb. 27, 1996
Slepian et al. (Slepian)	5,729,917	Mar. 24, 1998

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THE REJECTIONS

Claims 1, 11, 12 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Huff '491 or Huff '801.

Claims 2 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the references applied against claim 1 and further in view of Issler.

Claims 3 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the references applied against claims 2 and 12 and further in view of Rudy.

Claims 4, 5, 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the references applied against claims 1 and 12 and further in view of Bates.

Claims 6, 9 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the references applied against claims 1 and 15 and further in view of any one of Tilles, Marc, Gross or Boys.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being

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Claims 7, 8, 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the references applied against claims 6 and 15 and further in view of Slepian.

Claims 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the references applied against claims 1 and 12 and further in view of Boys.

Attention is directed to the brief (Paper No. 23) and answer (Paper No. 24) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.¹

DISCUSSION

The Huff patents, the examiner's alternative primary references, have essentially similar, if not identical, disclosures.² Each pertains to a shoe or boot manufactured by the so-called Goodyear welt system. Because this system applies tremendous pressure to the innersole during application of the welt stitch, the shoes/boots manufactured thereby require a rigid

¹ The above statements of rejection mirror those set forth in the answer (note: in the answer canceled claim 23 was

innersole board which can make the shoes/boots uncomfortable to wear (see Huff '801 at column 1, lines 17 through 30, and Huff '491 at column 1, lines 20 through 33). To solve this problem, Huff provides a rigid innersole board having detachable pieces at the heel and forefoot impact areas which remain connected to the board during the manufacturing process until shortly after the application of the welt stitch. As described in each patent,

[a]s shown in FIG. 4, the welt stitch (17) is applied through the rib (13), upper lining material (27), upper (18), and PVC welt material (19), as is normal procedure in any shoe or boot manufactured with the Goodyear welt system. (Ibid.)

The pre-cut detachable pieces (11a, 11b) on the innersole board (10) are now removed As best shown in FIG. 2, the fresh openings (11a', 11b') expose the high density EVA pad (15) that lies on top of the innersole board (10). In the preferred embodiment, the two cushioning pads (20a, 20b) are made of polyurethane and cemented to the high density EVA pad (15) through the new openings (11a', 11b'). . . .

As can be seen in FIGS. 2 and 4, a filler (21) of uniform thickness is die cut to fit inside the rib (13) and cemented to the innersole board (10). . . .

A shank (23) is applied in its normal position, as shown in FIGS. 2 and 4

Turning now to FIG. 4, the midsole (24) is applied and stitched to the welt material (19), locking in place the cushioning pads (20a, 20b), shank (23), and EVA rib filler (21), and compressing the cushioning

The examiner (see page 4 in the answer) concedes that neither Huff patent meets the limitations in independent claims 1 and 12 requiring a midsole having an upstanding sidewall integrally molded with and around its periphery. Huff's midsole 24 has no such sidewall. Nonetheless, the examiner likens Huff's welt material 19 to an upstanding sidewall or rim extending around the midsole 24 (see page 3 in the answer), and submits that

[i]t has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Howard v[.] Detroit Stove Works, 150 U.S. 164 (1893); see also In re Heinrich, 268 F.2d 753, 756, 122 USPQ 388, 390 (CCPA 1959). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the midsole and the upstanding rim of [e]ither of the Huff references by forming them as one piece, to decrease cost by eliminating the steps of separately molding the pieces and fastening them together [answer, page 4].

As is evident from Figure 4 in the Huff patents, however, if the welt material 19 were integrally molded with the midsole 24, the midsole would prevent, after the application of the welt stitch 17, the removal of the detachable pieces 11a and 11b from

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examiner would completely frustrate Huff's objective of enhancing the comfort of shoes and boots manufactured via the Goodyear welt system. In this light, it is evident that the Huff references actually would have led the artisan away from the proposed modification, and that the only suggestion therefor stems from hindsight knowledge impermissibly derived from the appellant's disclosure.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 1 and 12, and dependent claims 11 and 20, as being unpatentable over either Huff '491 or Huff '801.

As the other prior art items applied by the examiner do not cure the foregoing deficiency of the Huff references relative to the subject matter recited in independent claims 1 and 12, we also shall not sustain the 35 U.S.C. § 103(a) rejections of dependent claims 2 through 10, 13 through 19, 21 and 22.

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SUMMARY

The decision of the examiner to reject claims 1 through 22
is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
)	
)	APPEALS AND
JOHN P. MCQUADE)	
Administrative Patent Judge)	INTERFERENCES
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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